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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/451,160
Filing Date: November 30, 1999
Appellant(s): BOAL, STEVEN R.

Alex Chan
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 7/5/07 appealing from the Office action mailed 10/4/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Linden	6,360,254	March-2002
Barnett	6,321,208	Nov-2001
Lang	2003/0083931	May-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linden (6,360,254) in view of Barnett (6,321,208).

Claims 24 and 25: Linden discloses associating a URL with a coupon, a promotional code being appended to the URL; invoking use of the URL with a browser to thereby enable a user to redeem the coupon; disabling future use of the invoked URL; and displaying coupons, gift certificates, and other objects which can be selected (Figures 1, 2, 3a, 5, 8, 9, 10; and the below citations):

“In a Web site system in which different private records or other resources are personal to different users, a method is provided for allowing users to securely access a private resource without the need to enter a username, password, or other authentication information, and without the need to download special authentication software or data to the user's computer. Each resource is assigned a private uniform resource locator (URL) which includes a fixed character string and a unique token, and the URLs are conveyed by email (preferably using hyperlinks) to users that are entitled to access such resources. The tokens are

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generated using a method which distributes the tokens substantially randomly over the range of allowable token values ("token space"). The token space is selected to be sufficiently large relative to the expected number of valid tokens to inhibit the identification of valid tokens through trial and error. When a user attempts to access a private URL (such as to access a private account information page), a token validation program is used to determine whether the token is valid. The method may be used to provide users secure to access private account information on the Web site of merchant. Other practical applications include electronic gift certificate and coupon redemption, gift registries, order confirmation electronic voting, and electronic greeting cards (Abstract);

[Claim] 29. The computer system of claim 16, wherein the server system implements an electronic coupon system in which the private URLs provide one-time-use discounts to users.

Additionally, Linden further implies a coupon request(col 6, lines 14-22; claim 1).

Linden does not explicitly disclose a coupon request.

However, Barnettt discloses a coupon request (Figure 1).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Barnett's coupon request to Linden's coupon and promotion system. One would have been motivated to do this in order to better offer promotions capabilities to users for goods and services.

Claims 1-18 and 22, 23 and 47 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linden (6,360,254) in view of Barnett (6,321,208) in view of Lang (2003/0083931).

Linden and Barnett disclose the features of claims 24 and 25.

Claims 1-3, 5-18 and 22, 23 are dependent upon claims 24 and 25.

Claims 1-3, 5-8, 14-17:

Linden further discloses the user utilizing the Internet and accessing webpages, shopping, and receiving advertising (Fig. 5, 7, 9, 10).

Linden does not explicitly disclose targeting devices.

However, Lang discloses targeting devices.

In regards to claims 1-3, 5-8, 14-17, Lang discloses:

collecting device information from a client system, the device information being insufficient to specifically identify the user of the client system;

associating a device ID with the device information at a main server system, the device ID being insufficient to specifically identify the user;

selecting said coupon according to the device ID to thereby identify the coupon appropriate for said user based on the device information; and,

transmitting the selected coupon from the main server system to the client system (Fig 2; Fig. 3; Abstract; Paragraphs [9; 11; 14; 15; 17]).

Notice in the above citations from Lang that the electronic device and/or the user may be targeted and tracked. Hence, Lang discloses that the electronic device, without

a specific identification of the user, can be tracked and targeted (see the above citations, particularly paragraph [17]).

Note in Paragraph [17] that Lang states that “In addition. . .the actual name may. . .may also be collected. . .”. Also, notice in Lang that the information concerning user devices is available without intruding on the user.

Therefore, it would be obvious to one skilled in the art that Lang’s invention can be enacted without necessarily accessing the specifically user identifying information but rather based on the device information. One would be motivated to do this in order to target users based on the available information and without further intruding the users.

Also, while Lang discloses advertising targeted to user devices, Lang does not explicitly disclose coupons.

However, Lang discloses marketing, advertising, and promotions ([3]). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Lang’s targeted marketing, advertising, and promotions can include coupons. One would have been motivated to do this in order to present marketing, advertising, and promotions that are in a form of possible interest to the user.

Also, in regards to claim 2, Lang discloses obtaining location related information ([17, 29]). Lang does not explicitly disclose utilizing postal or zip codes. However, Lang discloses determining location automatically, and also collecting information

In the above, Lang discloses that user devices can be targeted and that the user device can be useful for determining information that will be of more likely interest to the user.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Lang's targeting devices to Linden's user utilizing the Internet and accessing webpages, shopping, and receiving advertising. One would have been motivated to do this in order to better present offers of interest to the user.

Claim 4: Linden does not explicitly disclose printing the coupons. However, Barnett discloses uniquely identifying the coupons and printing the coupons (Fig. 1, 2, 3, 5; col 7, lines 20-35).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Barnett's printing coupons to Linden's providing coupons or Lang's providing advertisements. One would have been motivated to do this in order to better give the user a useful way to utilize the coupon/advertisement.

Claims 9 and 10: Lang discloses the above but neither of the references explicitly disclose that the graphical user interface on the client device uses icons which may also flash to indicate the availability of new coupons. However, Official Notice is again taken that the use of icons, graphics, colors, animation, etc. to attract the viewer's attention on graphical user interfaces is well known in the computer arts, and their use would have been obvious to one having ordinary skill in the art at the time the invention was made. In support of this Official Notice, the Examiner previously provided excerpts from two

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HTML textbooks from 1996 to show that, not only was it well known to "flash" parts of a web page to attract the user's attention, but that the "Blink" command was also one of the standard commands in the programming language (Graham, "The HTML Sourcebook, Second Edition, A Complete Guide of HTML 3.0", 1996, pp 233-234)(Lemav, "Teach Yourself Web Publishing with HTML 3.0 in a Week", 1996, pp 183). Therefore, one would have been motivated to use icons, flashing or otherwise, to notify the user of the Linden system in order to attract their attention more easily.

Claims 11-13, 18, 22, 23: Lang discloses the above, but neither reference explicitly discloses that the coupon data is encrypted before it is sent to the client system nor that the client system will also encrypt the coupon data upon receiving the data from the remote server. Official Notice is taken that it is old and well known within the computer and data encryption arts to encrypt data being sent over unsecured networks using a plurality of encryption methods in order to provide a higher level of security to the data. In support of this Official Notice the Examiner previously provided Chapter 15 from a cryptography textbook from 1996 to show that not only was double encryption a well known method to further protect data, but triple encryption and other multiple encryption schemes were also well known and used in the art (Schneier, "Applied Cryptography, Second Edition", 1996, pp 357-368). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to encrypt the coupon data in Lang, prior to transmitting the data over an unsecured network, such as the Internet as disclosed by Lang, in order to prevent unauthorized interception of the data. It also would have been obvious to one having ordinary skill in

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the art at the time the invention was made to use a local encryption method to further encrypt and protect the encrypted data received from the remote server. One would have been motivated to further encrypt the coupon data in Linden, locally in this manner in order to prevent unauthorized disclosure of the selected coupons to other persons who may use the client device (e.g. other family members, co-workers, etc.).

Additionally, see the claim rejection for claims 47 and 48 below.

Claims 47, 48: Linden and Barnett disclose the above. Linden discloses utilizing encryption (see Linden rejection). Linden does not explicitly disclose encryption of the coupon.

However, Barnett further discloses a coupon request, storing the coupon, and that the coupon can be encrypted (Figure 1; Figure 5; col 11, lines 10-25). Barnett further discloses identifying the user or user device and that this information can be placed on the coupon (col 11, lines 3-7; col 11, lines 10-26). Barnett further discloses encryption transmittal of unique coupon identifying information (col 13, lines 50-60).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that coupon security/encryption can be utilized for coupon communication. One would have been motivated to do this in order to better prevent fraud.

Claims 26-46, 49-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lang (2003/0083931) in view of Barnett (6,321,208).

Claim 26, 28, 30-33, 39-42, 44, 45, 46:

Lang further discloses collecting device information from a client system, the device information being insufficient to specifically identify the user of the client system; associating a device ID with the device information at a main server system, the device ID being insufficient to specifically identify the user; selecting said coupon according to the device ID to thereby identify the coupon appropriate for said user based on the device information; and, transmitting the selected coupon from the main server system to the client system (Fig 2; Fig. 3; Abstract; Paragraphs [9; 11; 14; 15; 17]).

Notice in the above citations from Lang that the electronic device and/or the user may be targeted and tracked. Hence, Lang discloses that the electronic device, without a specific identification of the user, can be tracked and targeted (see the above citations, particularly paragraph [17]).

Note in Paragraph [17] that Lang states that “In addition. . .the actual name may. . .may also be collected. . .”. Also, notice in Lang that the information concerning user devices is available without intruding on the user.

Therefore, it would be obvious to one skilled in the art that Lang’s invention can be enacted without necessarily accessing the specifically user identifying information but rather based on the device information. One would be motivated to do this in order to target users based on the available information and without further intruding the users.

Also, while Lang discloses advertising targeted to user devices, Lang does not explicitly disclose coupons or a coupon request.

However, Lang discloses marketing, advertising, and promotions ([3]).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Lang's targeted marketing, advertising, and promotions can include coupons. One would have been motivated to do this in order to present marketing, advertising, and promotions that are in a form of possible interest to the user.

Additionally, Lang discloses marketing and advertising, promoting goods and services, targeting a group of consumers ([3]), improving the cost effectiveness of advertising ([5]), targeting users and tracking purchases ([6, 7]). Lang further discloses selling and purchasing ([29, 31]). Hence, it would be obvious to one skilled in the art that Lang can send a coupon to a user as way to do all of the above.

However, Barnett discloses a coupon request (Figure 1).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Barnett's coupon request to Lang's and targeted promotions and purchasing/selling inciting. One would have been motivated to do this in order to better offer promotions capabilities to users for goods and services or to better promote purchasing/selling.

Claim 27: In regards to claim 27, Lang discloses obtaining location related information ([17, 29]). Lang does not explicitly disclose utilizing postal or zip codes. However, Lang discloses determining location automatically, and also collecting information

Claims 34, 35: Lang discloses the above but neither of the references explicitly disclose that the graphical user interface on the client device uses icons which may also

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flash to indicate the availability of new coupons. However, Official Notice is again taken that the use of icons, graphics, colors, animation, etc. to attract the viewer's attention on graphical user interfaces is well known in the computer arts, and their use would have been obvious to one having ordinary skill in the art at the time the invention was made. In support of this Official Notice, the Examiner previously provided excerpts from two HTML textbooks from 1996 to show that, not only was it well known to "flash" parts of a web page to attract the user's attention, but that the "Blink" command was also one of the standard commands in the programming language (Graham, "The HTML Sourcebook, Second Edition, A Complete Guide of HTML 3.0", 1996, pp 233-234)(Lemav, "Teach Yourself Web Publishing with HTML 3.0 in a Week", 1996, pp 183). Therefore, one would have been motivated to use icons, flashing or otherwise, to notify the user of the Lang system in order to attract their attention more easily.

Claims 36, 37, 38, 43: Lang discloses the above, Lang does not explicitly disclose that the coupon data is encrypted before it is sent to the client system nor that the client system will also encrypt the coupon data upon receiving the data from the remote server. Official Notice is taken that it is old and well known within the computer and data encryption arts to encrypt data being sent over unsecured networks using a plurality of encryption methods in order to provide a higher level of security to the data. In support of this Official Notice the Examiner previously provided Chapter 15 from a cryptography textbook from 1996 to show that not only was double encryption a well known method to further protect data, but triple encryption and other multiple encryption schemes were also well known and used in the art (Schneier, "Applied Cryptography,

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Second Edition", 1996, pp 357-368). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to encrypt the coupon data in Lang, prior to transmitting the data over an unsecured network, such as the Internet as disclosed by Lang, in order to prevent unauthorized interception of the data. It also would have been obvious to one having ordinary skill in the art at the time the invention was made to use a local encryption method to further encrypt and protect the encrypted data received from the remote server. One would have been motivated to further encrypt the coupon data in Lang, locally in this manner in order to prevent unauthorized disclosure of the selected coupons to other persons who may use the client device (e.g. other family members, co-workers, etc.).

Additionally, see the claim rejection for claims 49 and 50 below.

Claim 29: Lang does not explicitly disclose printing the coupons. However, Barnett discloses uniquely identifying the coupons and printing the coupons (Fig. 1, 2, 3, 5; col 7, lines 20-35).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Barnett's printing coupons to Lang's providing advertisements. One would have been motivated to do this in order to better give the user a useful way to utilize the coupon/advertisement.

Claims 49, 50: Lang and Barnett disclose the above. Lang does not explicitly disclose encryption of the coupon.

However, Barnett further discloses a coupon request, storing the coupon, and that the coupon can be encrypted (Figure 1; Figure 5; col 11, lines 10-25). Barnett

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further discloses identifying the user or user device and that this information can be placed on the coupon (col 11, lines 3-7; col 11, lines 10-26). Barnett further discloses encryption transmittal of unique coupon identifying information (col 13, lines 50-60).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that coupon security/encryption can be utilized for coupon communication. One would have been motivated to do this in order to better prevent fraud.

(10) Response to Argument

Examiner notes that the combination of the prior art renders obvious the features of the Appellant's representative independent claim 24. Note that claim 24 is the first independent claim.

In reference to independent claim 24, the combination of the prior art renders obvious:

receiving a coupon from a server (Linden, Figures 2, 3a; col 11, lines 15-23, claim 29; Barnett, Figure 1, Abstract);

associating a Uniform Resource Locator (URL) with the coupon, the URL containing a promotional code (Linden, Fig. 3a; col 11, lines 15-23; claim 16, 29);

invoking use of the URL with a browser to thereby enable a user to redeem the coupon (Linden, claim 29);and,

disabling future use of the invoked URL (Linden, claim 29, "one time use discounts to users").

And, the preceding is obvious in light of the rejection above.

I.a.

On page 4 of the Appellant's Arguments dated 7/5/2007, Appellant states, "a. Linden's Gift Certificate Is Not The Same As Applicant's Claimed Coupon... Claim 24 recites in part receiving a coupon from a server."

I.b.

On page 5, Appellant states, "b. Linden Does Not Teach Or Suggest "receiving a coupon from a server".

However, Linden discloses communication with a user involving servers (Figures 1, 2). And, Linden discloses sending via a server an e-mail to the user that includes a discount for a purchase (Fig. 2, see "Email" with "Link"; Fig. 3a, see "Incorporate Token Into URL and Transmit URL by Email to User's Email Address; and below citations):

"Another practical application (not separately illustrated) involves sending the user 70 (FIG. 2) an email document 72 or a Web page which includes a one-time-use URL (preferably as a hyperlink 74) to a private discount page 78. The discount page 78 may, for example, give the user a 10% discount off the user's next purchase. Other users of the system would be sent like emails but which contain different tokens. In this application, the server application 40 would use the tokens to prevent users from obtaining multiple discounts. This may be accomplished, for example, by deleting each issued token from a table once the token has been used (col 11, lines 15-23).

[claim] 29. The computer system of claim 16, wherein the server system implements an electronic coupon system in which the private URLs provide one-time-use discounts to users”.

Also, Linden further discloses that the invention utilizes coupons:

“The method may be used to provide users secure to access private account information on the Web site of merchant. Other practical applications include electronic gift certificate and coupon redemption, gift registries, order confirmation electronic voting, and electronic greeting cards (Abstract).

In one embodiment, the method is used to allow users to securely access and update a subscription profile for an automated email-based product recommendation service. Other practical applications for the method include automated order confirmation, electronic gift certificate and coupon redemption, access to gift registries, electronic voting, and access to electronic greeting cards (col 2, lines 50-57).

The method is particularly useful for enabling users of a merchant's Web site to access account-specific information and functions. For example, the method can be used to enable customers, suppliers, and/or business partners of a merchant to access information about business transactions with the merchant. This information may include payment and shipping information, information about prior and pending orders, subscription information, and other types of private information. The method may also be used to enable a user to securely perform a particular type of transaction, such as confirm an order, redeem an electronic gift certificate or coupon, or cast a vote. (col 3, lines 44-55)

The Web server 36 communicates with an application program 40 ("server application") which provides restricted access to a back-end database 42. As described below, the server application may, for example, implement a particular user service, such as an email notification service, an order processing service, or an electronic gift certificate or coupon service. The server application 40 may, for example, run on the computer or set of computers used to implement the Web server 36" (col 6, lines 15-22).

Furthermore, Barnett was added to Linden in a 35 USC 103(a) rejection.

And, Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to. Also, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

And, Barnett was added to further demonstrate a coupon request or receiving a coupon from a server. And, Barnett clearly discloses receiving a coupon from a server. The Title of Barnett's invention is "Method and System for Electronic Distribution of Product Redemption Coupons". Barnett's Abstract states, "Provided is a method and system for the electronic distribution of product redemption coupons to remote personal computers located at users' homes. A centrally located repository, such as an online service provider or web site on the Internet, stores packages of coupon data for downloading on demand to the user's computer." And, Barnett's Figure 1 shows a

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Personal Computer (item 6) connected to an Online Service Provider and/or Internet Website (item 2) so that Coupons can be requested and Coupons can be provided and/or electronic redemption can occur (item 4). Hence, Barnett clearly demonstrates receiving a coupon from a server.

Hence, the combination of the prior art clearly demonstrates receiving a coupon from a server.

I.c.

On page 5, Appellant states, "c. Linden Does Not Teach Or Suggest a URL With A Promotional Code".

Also, on page 6, Appellant states, "A promotional code identifies a promotion".

Examiner notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In interpreting claim language, the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art is applied, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description. See *In re Morris'*, 127 F.3d 1048, 1054 (Fed. Cir. 1997). See also *In ream. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) and *In re Sneed*, 710 F.2d 1544, 1548 (Fed. Cir. 1983). Claims are given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000). It is

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Appellant's burden to precisely define the invention. See *In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997).

And, Applicant's claims state minimal specific features as to the characteristics of the promotional code contained in the URL. Hence, the promotional code in the URL is open to a broad interpretation.

And, Linden discloses a promotional code contained in a URL associated with a coupon.

Figure 3a of Linden shows "Generate URL of Private Resource". . ."Incorporate Token Into URL and Transmit URL By Email to User's Email Address".

Linden further discloses how a promotional code contained in a URL associated with a coupon is provided:

"Another practical application (not separately illustrated) involves sending the user 70 (FIG. 2) an email document 72 or a Web page which includes a one-time-use URL (preferably as a hyperlink 74) to a private discount page 78. The discount page 78 may, for example, give the user a 10% discount off the user's next purchase. Other users of the system would be sent like emails but which contain different tokens. In this application, the server application 40 would use the tokens to prevent users from obtaining multiple discounts. This may be accomplished, for example, by deleting each issued token from a table once the token has been used (col 11, lines 15-23).

[claim] 16. A computer system for providing secure Web-based access to private resources over a publicly-accessible network without requiring users to enter authentication information, comprising:

a database which includes a plurality of private records, wherein different private records correspond to different users; and

a server system which communicates with Web clients over the publicly-accessible network to provide restricted user access to the private records, the server system including a server application that (a) generates tokens which correspond to specific private records . . . (b) generates private uniform resource locators (URLs) which include the tokens, (c) transmits the private URLs to corresponding users to enable the users to access corresponding private records, and (d) validates tokens received from Web clients in URL requests;

wherein the server system responds to a URL request which includes a valid token by returning information contained in a private record which corresponds to the token, without requiring user entry of authentication information.

[claim] 29. The computer system of claim 16, wherein the server system implements an electronic coupon system in which the private URLs provide one-time-use discounts to users”.

Note in these figures and citations that the specific promotional code/token that identifies the specific coupon is included in the URL. The URL can be clicked on to uniquely go to and uniquely identify a specific coupon/promotion. Then, the promotional code/token must match in order for the coupon to be provided. The promotional URL in Linden is matched against the list of possible promotions/coupons to ensure that the coded URL is a valid promotion/coupon. Hence, Linden discloses a URL associated with a coupon and that the URL utilizes a promotional code.

Hence, Linden discloses a promotional code contained in a URL associated with a coupon (as shows preceding, Fig. 3a; col 11, lines 15-23; claims 16, 29).

I.d.

On page 7, Appellant states, "Further, Applicant respectfully asserts that the Examiner has failed to provide any indication where in the Barnett reference Applicant's claimed "receiving a coupon" limitation is taught or suggested."

Please see the response to I.a. and I.b. preceding where it is clearly shown how Barnett demonstrates receiving a coupon or receiving a coupon from a server.

II.a.

On page 7, Appellant states, " a. Lang and Barnet Do Not Disclose Or Suggest Device Information Being Insufficient To Specifically Identify A User".

Examiner notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In interpreting claim language, the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art is applied, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description. See *In re Morris'*, 127 F.3d 1048, 1054 (Fed. Cir. 1997). See also *In ream. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) and *In re Sneed*,

710 F.2d 1544, 1548 (Fed. Cir. 1983). Claims are given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000). It is Appellant's burden to precisely define the invention. See *In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997).

And, Appellant Specification discloses tracking the user's machine in order to better target the user but without personally identifying the user (Appellant's Specification Page 10, lines 5-36):

"User identification ID 30 may comprise a multi-digit number that is assigned by main server system 12, more particularly, database server 24, when a user registers with coupon distribution system 10. User ID 30 may have a format, such as XXX/XXXXXXXX, where X is a digit between 0-9. The user ID, however, does not specifically identify the user personally, but rather, more accurately associates a physical machine defining client system 14 with user profile information obtained during registration. User identification 30 is stored on client system 14 as a part of a UserInfo object, and is provided to main server system 12 when making requests, for example, for new coupon data. Main server system 12 can then correlate the provided user ID 30 with user information stored in a profile database. The user information may then be used in identifying coupons suitable for the user. Significantly, however, the user is not personally identified nor is it even possible (e.g., through the "hacking" of server system 12) to identify the user personally, as such information is not even collected from the user. Accordingly, the approach described herein maintains privacy of the user of system 10.

The UserInfo object further includes user information collected from the user of client system 14 indicative of one or more demographic characteristics of the user. Significantly, the user information is insufficient to specifically identify the user. In a constructed embodiment, such information comprises a postal zip code associated with the user, and a state in which the user resides. Client application 28 allows the user to update this information after initial registration. In addition, the UserInfo object includes the mode in which the Internet is accessed, for example, through use of a modem (e.g., dial-up), through use of a Local Area Network (LAN), or use of a proxy server. The UserInfo object may further include the version number of the client application software 28.”

And, Lang discloses recording and tracking device identifying information in order to better target. And, Lang discloses device information being insufficient to specifically identify the user. Note in these citations that Lang tracks and target's the device. Lang does not collect user information. Lang discloses:

“[claim] 1. A method of marketing to users of an electronic device connected via a wireless connection to a wide area network, comprising the following steps:

- a. identifying an electronic device connected to a wide area network;
- b. determining the physical location of said electronic device when connected to said wide area network;
- c. creating a user file containing the identity and physical location information of said electronic device;
- d. selecting advertising material to be sent to said electronic device; and

e. transmitting said advertising material to said electronic device over said wide area network using the identity and physical location information in said user file.

[0011] It is another object of the present invention to provide such a method of marketing that enables advertisers to more specifically target their advertising to such users or their electronic devices according to the web sites or files previously visited on the wide area network.

[0017] All of the above information is then collected by a database generator to create a user file. When a plurality of user files are created, the database generator transmits ads to selected users of electronic devices over the wide area network for a particular advertiser, or delivers all or selected portions of the database to advertisers to transmit advertisements themselves over the wide area network to these users. In each delivery scheme, the advertisements transmitted to targeted users are based on their electronic device's ID identification information, the electronic device's or user's network activities on the wide area network and the past, present or future physical locations of the electronic device or user when connected to the wide area network. In addition, the actual name of the user may be used and added to the user file. Other personal information about the user, such as name, gender, age, occupation, marital status, etc., may also be collected and added to the user file to further target the users.”

Note in these citations that Lang repeatedly states that the electronic device OR the user can be tracked, that the location of the electronic device OR the user can be tracked and that the actual name of the user MAY be used.

Examiner notes that teaching of a preference or several options does not constitute a teaching away from the proposed combination under review. See In re Fulton, 391 F.3d 1195, 1199-1200, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

Also, notice the Abstract in Lang:

“A method of advertising to mobile users of an electronic device linked to a wide area network. The method enables advertisers to more effectively target their advertisements to mobile users using a user file that includes their electronic device ID information, their past, current network connection activity, and the past, current or anticipated physical locations. The method includes the first step of obtaining the device's ID information when connected to the wide area network. Next, information regarding the network connection activity of the electronic device or the user over the wide area network is obtained. Next, the past, current or anticipated physical locations of the electronic device when connected to the wide area network is determined. . .”

(Lang, Abstract).

Notice in the Abstract that the information of the electronic device is necessarily obtained and tracked. And, that the user name or personal information is additional or optional information that can be tracked. And, in Lang, the device is tracked and then information about a user is inferred based upon the activity of the device itself. Hence, Lang discloses that just the device is tracked such that the user activity can be inferred, however, the actual user name (or personally identifying information) is not necessarily known.

Also, note in the rejection that a 35 USC 103 rejection was made and that it was stated in the rejection dated 10/4/06 on page 9 that, "Therefore, it would be obvious to one skilled in the art that Lang's invention can be enacted without necessarily accessing the specifically user identifying information but rather based on the device information. One would be motivated to do this in order to target users based on the available information and without further intruding the users." Hence, any one skilled in the art would know, as shown in Lang's disclosure, that Lang's invention can be performed with device ID identifying information alone Or that the invention could be performed with the device ID identifying information and the optional user name information also added on.

Also, notice in independent claim 1 (Lang, claim 1) that no personal or personally identify information of a user is collected. Rather, only device id identifying information is utilized for targeting purposes. It is not until dependent claim 8 (Lang, claim 8) that personally identifying user information is also added on to the already obtained and utilized device ID identifying information. Hence, Lang discloses several version of his invention. In one version, Lang discloses that device ID identifying information is collected. In another version, Lang discloses that device ID identifying information is collected and also that user personal information is optionally also collected and added to the already known device information.

Hence, Lang discloses collecting device ID identifying information and targeting based on device ID identifying information.

Hence, Lang renders obvious device information being insufficient to specifically identify a user.

II.b.

On page 10, Appellant states, " b. Lang and Barnett Do Not Disclose Or Suggest Receiving A Coupon Request, Selecting A Coupon And Transmitting The Selected Coupon".

Examiner notes that Barnett was added to Lang in a 35 USC 103(a) rejection.

And, Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to. Also, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Also, in regards to the obviousness of coupons, Lang discloses marketing and advertising, promoting goods and services, targeting a group of consumers ([3]):

"[0003] The present invention relates generally to the field of marketing and advertising. More particularly, this invention relates to a method of marketing wherein an advertiser desiring to promote its goods or services to a targeted group of consumers who use a computer linked to a wide area network."

Lang further discloses improving the cost effectiveness of advertising ([5]), targeting users and tracking purchases ([6, 7]). Lang further discloses selling and purchasing ([29, 31]).

And, Barnett was added to demonstrate a receiving a coupon request, selecting a coupon and transmitting the selected coupon. Barnett clearly discloses a coupon request and transmitting the coupon. The Title of Barnett's invention is "Method and System for Electronic Distribution of Product Redemption Coupons". Barnett's Abstract states, "Provided is a method and system for the electronic distribution of product redemption coupons to remote personal computers located at users' homes. A centrally located repository, such as an online service provider or web site on the Internet, stores packages of coupon data for downloading on demand to the user's computer." And, Barnett's Figure 1 shows a Personal Computer (item 6) connected to an Online Service Provider and/or Internet Website (item 2) so that Coupons can be requested and Coupons can be provided and/or electronic redemption can occur (item 4).

And, Barnett further discloses targeting coupons or selecting coupons (Fig. 9, "Obtain User Data and Product Data", "Analyze Data to Determine Subsequent Coupon Sets", "Distributor Provides Coupon Data to Online Service"). Barnett further discloses targeting coupons or selecting coupons (Fig. 10, "Marketing and Targeting Analysis" then "Coupon Package" which goes "To/From Users").

Hence, Barnett discloses receiving a coupon request from a user, selecting a coupon or targeting coupons, and then transmitting the selected coupon to the user.

Hence, Barnett discloses receiving a coupon request, selecting a coupon and transmitting the selected coupon.

III.

Please see the Response to Arguments for II.a. above.

Also, Examiner notes that the following prior art made of record and not relied upon is considered pertinent to Appellant's invention:

a) Woolston (20050262005) discloses URLs associated with coupons:

"[0054] The instance of the dynamic stream, the navlet of bid/ask information, may be further propagated or populated with electronic coupons 610 or advertisements, not shown. The electronic coupon 610 may provide a URL link and access code information to unlock or decode electronic coupon information to provide support for discount or loyalty program participation. In one mode of the system the navlet or dynamic bid/ask pricing streaming display may be vertically scaled to support one-half sized Internet advertising placards. In another mode of the system, the navlet may detect the horizontal size of the display on which it appears to horizontally scale the size of the navlet. The system, as discussed further below, may distribute Internet advertising and coupons based on taxonomic, user profile information, or other routable and distribution schemes provided by the system."

Art Unit: 3622

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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9/23/2008

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